

## REMARKS

### The Response

Claims 1, 5, 8-12, 20-28, and 30 are pending.

### **Rejection Under §102**

Claims 1, 8-11, and 20-28 have been rejected under 35 U.S.C. §102(b) for allegedly being anticipated by J.M. Gomez-Vega et al., "A multilayer approach to fabricate bioactive glass coatings on Ti alloys", presented at the Materials Research Society (MRS) 1998 Fall Meeting on December 1, 1998 or alternately the paper entitled "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" available via Lawrence Berkeley National Laboratory. Applicants respectfully traverse this rejection in that neither papers are prior art under 35 U.S.C. §102(b).

The presentation of "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" at the MRS 1998 Fall Meeting on December 1, 1998 is distinguished from the presentation in *In re Klopfenstein*, No. 03-1583 (Fed. Cir., 2004). The MRS presentation is a talk from 3:30 p.m. to 3:45 p.m. (see the Tuesday afternoon schedule for December 1, 1998 attached to the Office Action), while the presentation in *In re Klopfenstein* is a "slide presentation **printed and pasted onto poster board**" (Office Action, page 3). Accordingly, the subject presentation at the MRS 1998 Fall Meeting on December 1, 1998 is not a printed publication.

Following the MRS 1998 Fall Meeting, MRS published the MRS Symposium Proceedings, Vol. 550 "Biomedical materials- Drug Deliver, Implants and Tissue Engineering" which contains the paper entitled "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" (as attached to the Office Action). Applicants submit a Declaration under 37 C.F.R. § 1.132 by the undersigned attorney of record declaring that the paper entitled "A multilayer approach to fabricate bioactive glass coatings on Ti alloys", published in the MRS Symposium Proceedings, Vol. 550 "Biomedical materials- Drug Deliver, Implants and Tissue Engineering" has a publication date of May 21, 1999. Having a publication date on May 21, 1999 means that this paper is not a prior art to this present application under 35 U.S.C. §102(b), since the present application has a priority date of May 1, 2000.

Applicants submit a further Declaration under 37 C.F.R. § 1.132 by Ms. Jean Wolslegel, the Reports Coordinator of Lawrence Berkeley National Laboratory Library declaring that the earliest possible date the library first made the paper entitled "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" available to the public online is October 9, 2001. Having publication date on or after October 9, 2001 means that this paper is not a prior art to this present application under 35 U.S.C. §102(b), since the present application has a priority date of May 1, 2000.

Since none of the cited papers are prior art under 35 U.S.C. §102(b), the Applicants respectfully request the Examiner to withdraw this rejection.

### **Rejection Under §103**

Claims 5, 12, and 30 have been rejected under 35 U.S.C. §103(a) for allegedly being rendered obvious by J.M. Gomez-Vega et al., "A multilayer approach to fabricate bioactive glass coatings on Ti alloys", presented at the MRS 1998 Fall Meeting on December 1, 1998 or alternately the paper entitled "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" available via Lawrence Berkeley National Laboratory, in view of Gomez-Vega et al., "Novel Bioactive Functionally Graded Coatings on Ti6Al4V" Advanced Materials 12(12): 894-897 (2000). Applicants respectfully traverse this rejection.

Claims 5, 12, and 30 are directed to a multilayer article comprising: a metal substrate, a first layer comprising an inner and outer surface, said first layer comprising a glass composition, a first intermediate layer having an inner and outer surface, and said first intermediate layer is located between the substrate and the first layer.

For the reasons provided earlier, J.M. Gomez-Vega et al., "A multilayer approach to fabricate bioactive glass coatings on Ti alloys", presented at the MRS 1998 Fall Meeting on December 1, 1998, and the paper entitled "A multilayer approach to fabricate bioactive glass coatings on Ti alloys" available via Lawrence Berkeley National Laboratory are not prior art.

The remaining disclosure, Gomez-Vega et al., "Novel Bioactive Functionally Graded Coatings on Ti6Al4V" Advanced Materials 12(12): 894-897 (2000), alone does not teach or suggest a multilayer article comprising: a metal substrate, a first layer

comprising an inner and outer surface, said first layer comprising a glass composition, a first intermediate layer having an inner and outer surface, and said first intermediate layer is located between the substrate and the first layer.

Accordingly, the cited papers fails to render Claims 5, 12, and 30 obvious under 35 U.S.C. §103(a). As such, the Applicants respectfully request the Examiner to withdraw this rejection.

### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If in the opinion of the Examiner, a telephonic conference would expedite the prosecution of the subject application, Applicants encourage the Examiner to call the undersigned at (510) 486-4534.

If any fee is required to maintain pendency of this application, the Commissioner is authorized to charge any necessary and additional fees, including fees for additional extensions of time, that may be due to Deposit Account No. 120690, referencing Attorney Docket: IB-1627.

Respectfully submitted,

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